



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/577,614

04/20/2007

Simon Feldbaek Nielsen

65487(50533)

5411

21874 7590 10/02/2008
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER

CUTLIFF, YATE KAI RENE

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

10/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,614	Applicant(s) NIELSEN, SIMON FELDBAEK	
	Examiner YATE' K. CUTLIFF	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-58 is/are pending in the application.
- 4a) Of the above claim(s) 41,50 and 52-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39,40,42-49,51 and 55-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/13/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 39-49 and 51-57 drawn to the compound of formula I where Ar1 and Ar2 are aryl; and claim 58 in part, and the specific species D-001, (2-{3-[3-(2-Chloro-4-methoxy-phenyl)-3-oxo-propenyl]-3',5'-dimethyl-biphenyl-4-yloxy}-ethyl)-trimethyl-amonium, iodide (see page 30), in the reply filed on June 16, 2008 is acknowledged. Also, Applicant set out following designations.

Y1 is absent; m=0; Y2 is -O-Z-N+(R1)(R2) Q-; p=1; Z is -CH₂-CH₂; and R1, R2, R4 and all methyl.

The Examiner noted a typographical error in the designation of Y2, and on September 2, 2008 verified with Applicant's representative that "(C)" was on a designation for the substituent group. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-38 have been canceled.
3. Claims 39-49 and 51-58, are Ar1 and Ar2 are aryl, are under examination.
4. Claims 41, 50 and 52-54 is withdrawn as being drawn to a non-elected invention.

Information Disclosure Statement

5. The information disclosure statement filed October 13, 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the list of published foreign applications fail to provide the publication date of the application. Additionally, the publications listed do not identify the title of the document. It has been placed in the

application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 102

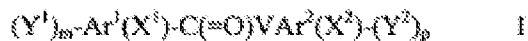
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

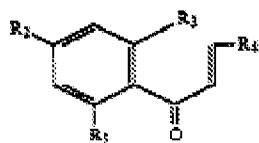
7. Claims 39-40, 42-49 and 55-58 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shinma et al.

8. The rejected claims cover, inter alia, the compound of formula I

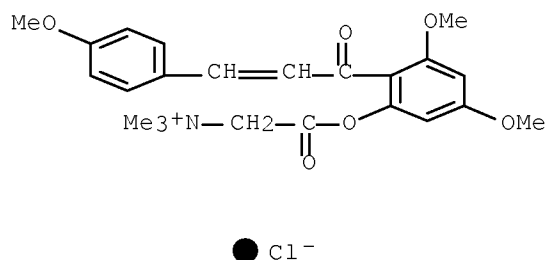


The substituents are defined by the rejected claims.

Shinma et al. discloses the following compound for treating mammals having infections.

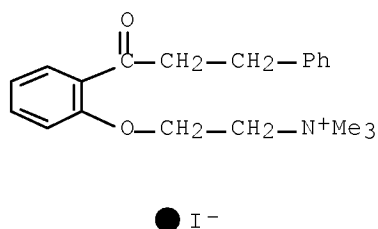


The above compound anticipates Applicant's compound of formula I when Shinma's R1 is hydrogen, R4 is benzimidazolyl, R2 and R3 are lower alkoxy as set out below.



- The reference teaches Applicant's compound as set out above.
9. Claims 39 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by DiPaco et al. (Annali di Chimica (Rome, It.), 1958).
 10. The rejected claims cover a compound of formula I, as set out above in paragraph 8 and where Z is $-(CH_2)_n-$, where n is 1-4.

Di Paco et al. disclose the compound of formula as set out below.



The reference teaches Applicant's compound as set out above.

Allowable Subject Matter

The elected species: (2-{3-[3-(2-Chloro-4-methoxy-phenyl)-3-oxo-propenyl]-3',5'-dimethyl-biphenyl-4-yloxy}-ethyl)-trimethyl-amonium, iodide, has been searched and is deemed free of the prior art. The search was therefore expanded as called for under current Office Markush examination practice, a compound-by-compound search, to include a single additional compound; where V is $-\text{CH}_2-\text{CH}_2-$, $-\text{CH}=\text{CH}-$ and $-\text{C}\equiv\text{C}-$; Ar1 and Ar2 are aryl (substituted or unsubstituted), Y1 and Y2 are independently $-\text{O}-$, $-\text{N}^+(\text{R}_1)(\text{R}_2)$, $-\text{Q}-$; and where p, m, Z, R1, R2, R4, Q and X1 and X2 are as defined in the claims, with the rejection set out above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YATE' K. CUTLIFF whose telephone number is (571)272-9067. The examiner can normally be reached on M-TH 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel M. Sullivan can be reached on (571) 272 - 0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yaté K. Cutliff
Patent Examiner
Group Art Unit 1621
Technology Center 1600

/Porfirio Nazario-Gonzalez/
Primary Examiner
Art Unit 1621